

Application Serial No.: 09/522,877
Amdt. dated June 3, 2003
Reply to Office Action of January 9, 2003

REMARKS/ARGUMENTS

The Office Action dated January 9, 2003 and the references cited therein have been carefully considered. In response to the Office Action, Applicant has amended Claims 6 and 13 to more specifically define the present invention. Support for the amendment can be found throughout the application. Specifically, support can be found on page 2, lines 9 - 13 and page 3, lines 11 - 24. Accordingly, Claims 6 - 19 are pending.

The Examiner has rejected the specification due to informalities. Accordingly, Applicant has amended the application on page 3, line 31 to correct the typographical error of "cm²" and has inserted --cm³-- since a volume of air is being measured. Applicant submits that now new matter has been added and respectfully submits that the specification is now in proper form for consideration.

A Petition for a Two-Month Extension of Time is enclosed herewith.

Claims 6-8, 10-15 and 17-19 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,784,164 to Adams et al. (hereinafter "Adams et al."). The Office Action states that Adams et al. teaches a layer of paper having a cellulose derivative coating for a cigarette comprising a tobacco strand made therefrom. The Office Action also states that cellulose derivative can be ethyl cellulose and can provide an air permeability of at least 20 Coresta units and/or greater than 50 Coresta units and that the quantity is at least 1g/m² is applied to the paper.

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Applicant respectfully submits that the Adams et al. reference teaches away from a coated paper having a high Coresta value as in the present invention. Specifically, Adams et al. in column 7, lines 24-25 teaches that after the paper is coated the porosity is below 200 Coresta and is often below 30 Coresta and usually at least 5 Coresta. Applicant submits that the Adams et al. reference teaches the reduction of air permeability of the paper which is an opposite teaching of the present invention which is to increase the Coresta value of the paper after being coated. Applicant further submits that Adams et al. does not teach or suggest that the cellulose derivative consists of at least two layer of coating on the paper as defined in Claim 6 and Claim 13, as amended, in the present application.

Accordingly, Applicant respectfully submits that Claims 6 and 13, as amended, and those claims depending therefrom patentably distinguish over the cited reference.

Claims 6-19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,784,164 to Adams et al. in view of U.S. Patent No. 5,722,433 to Ishino et al. (hereinafter “Ishino et al.”). The Office Action concedes that Adams et al. does not specifically disclose applying the cellulose derivative on both sides of the paper. The Office Action relies upon Ishino et al. which discloses that a coating composition may be applied to one or both sides of a cigarette paper to adjust the permeability thereof.

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It is well settled that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Additionally, when applying 35 U.S.C. §103, the references must suggest the desirability and thus the obviousness of making the combination without the benefit of impermissible hindsight vision afforded by the claimed invention. *Hodosh v. Block Drug Co., Inc.* 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986).

Applicant respectfully submits that one skilled in the art would not be motivated to combine the Adams et al. reference with the Ishino et al. reference. For the reasons set forth earlier, Applicant submits that the Adams et al. reference does not teach or suggest the present invention of applying of cellulose derivative consisting of at least two layers providing an air permeability of at least 20 Coresta units as defined in Claims 6 and 13 of the present application. Applicant further submits that the Ishino et al. reference relates to making water dispersible sheets for use as a filter plug or filter jointing paper. Specifically one would not be motivated to combine the Ishino et al. reference with the Adams et al. reference since the Ishino et al. reference deals specifically with water dispersible paper and the Adams et al. reference does not. Specifically, the Adams et al. reference deals with cigarette wrapping paper that is coated to reduce the porosity in a coated area.

The Ishino et al. reference discloses a water dispersible sheet for cigarette so that when the water is applied to the paper, the paper will fall apart or disperse. Thus, Ishino et al.

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teaches that the paper, after being coated, should have a low level of gas permeability with a property of high water dispersibility. (Column 2, lines 13-18). The teaching in Ishino et al. is to use the ethyl cellulose to improve the water dispersibility of the paper itself. Specifically, in Column 10, lines 7-9, it states that a "water soluble polymer" is to be used with the paper. The use of the ethyl cellulose in the Ishino et al. reference is the opposite of the present invention, where it is used to make paper water repellent and not water soluble. Accordingly, Ishino et al. does not teach or suggest using a cellulose derivative for water repellent impregnation of paper as defined in Claims 6 and 13, as amended, of the present application.

Accordingly, Applicant respectfully submits that one skilled in the art would not be motivated to combine the cellulose derivative coated paper as disclosed by Adams et al. with Ishino et al. teaching of a watered soluble paper since both references relate to different areas of the art and would not be combined.

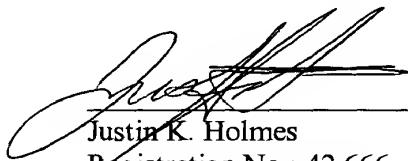
Applicant respectfully submits that Claims 6 and 13, as amended, and these claims depending therefrom patentably distinguish over the cited references.

Applicant has enclosed a check to cover the required fee for the Petition for a Two-Month Extension of Time. No other fees are deemed necessary, if however additional fees are necessary please charge deposit account number 08-2461.

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A Notice of Allowance is respectfully requested for Claims 6-19 in view of the amendment to the specification, claims as well as the remarks set forth above. Applicant respectfully believes that the present application is in all respects in condition for allowance, which action is earnestly solicited.

Respectfully submitted,



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